UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,031	08/16/2000	Arvind A. Raichur	30874-UT	3761

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EXAMINER
SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 August 2000_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-24_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _16 August 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _5_ .   6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: application filed on 08/16//2000, priority

filed 08/16/1999, IDS filed on 01/08/2001.

2.   Claims 1-24 are pending in the case. Claims 1, 9, and 17 are independent claims.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Independent claim 17 and dependent claims 18-24 are directed towards "computer

software providing . . ." to perform various steps. As presently drafted, the claim reads on a

computer software program per se, which does not constitute statutory subject matter as

prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by

amending the preamble to recite "Computer software stored on a computer readable medium".

The language in the preamble, "providing personalized search capabilities of hypertext

transmission protocol pages" does not render the claimed invention statutory because it in effect

constitutes intended use. See MPEP §2106:

> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this
> subject matter that must be examined. As a general matter, the grammar and intended meaning of terms
> used in a claim will dictate whether the language limits the claim scope. Language that suggests or
> makes optional but does not require steps to be performed or does not limit a claim to a particular
> structure does not limit the scope of a claim or claim limitation. The following are examples of
> language that may raise a question as to the limiting effect of the language in a claim:
> (A)   statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given

patentable weight or a cause for the preamble to be statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1, 7-8, 9, 15-16, 17, and 23-24 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Maarek et al. (hereafter referred to as Maarek), "WebCutter: a system

for dynamic and tailorable site mapping", Computer Networks and ISDN Systems 29,

1997.

Regarding independent claims 1, 9, and 17, Maarek teaches providing an index server

maintaining an index to hypertext transmission protocol pages in p. 1270, section 2, lines 1-5 and

a hierarchical plurality of topic categories in p. 1270, section 1, col. 1, lines 20-24. Maarek

teaches permitting a user to specify any subset of the plurality of topic categories in p. 1271,

section 2.1 and p. 1273, section 2.3, lines 1-4. Maarek teaches adding to a hypertext

transmission protocol page controlled by the user link information permitting execution of

searches of the index in any category of the subset but only of categories in the subset in p. 1270,

section 1, col. 1 line 8 – col. 2 line 18.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined the teaches of Maarek to have created the claimed invention. It

would have been obvious and desirable to have used the ability to browse and search hierarchical

topic subsets taught by Maarek to enhance the hierarchical and user customizable index also

taught by Maarek so that the user could add their manual input into the search to augment the

automatic capabilities of WebCutter.

Regarding dependent claims 7, 15, and 23, Maarek teaches permitting the user within a

branch of a hierarchy of categories to either include or exclude subcategories in the branch, or

both in p. 1273, section 2.3, lines 1-4.

Regarding dependent claims 8, 16, and 24, Maarek teaches reexecution of specifying a

subset of topic categories by a user in p. 1271, section 2.1 and p. 1273, section 2.3, lines 1-4.

6.   **Claims 2-6, 10-14, and 18-22 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Maarek et al. (hereafter referred to as Maarek), "WebCutter: a system

for dynamic and tailorable site mapping", Computer Networks and ISDN Systems 29, 1997

in view of Martinez et al. (hereafter referred to as Martinez), US 6,271,846 B1 filed

09/30/1998.

Regarding dependent claims 2, 10, and 18, Maarek teaches enabling a user to tailor or

cut the index map in p. 1271, section 2.1 and teaches other dynamic browsing hierarchies in p.

1270, section 1, col. 1 line 8 – col. 2 line 18. Maarek does not explicitly teach customizing the

topic categories. Martinez teaches customizable directories in fig. 4-5, and col. 1 line 6 – col. 5

line 18. It was well known to one of ordinary skill in the art at the time of invention that one

could organize files, such as hypertext transmission protocol pages, into a hierarchy of their

choosing. The names of topic categories could have been altered. New categories could have

been created and populated, and old categories could have been deleted. It was well known that the index could have been available on a network to a plurality of users.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the Martinez into Maarek to allow for permitting the user to propose addition of a hypertext transmission protocol page to the index server in conjunction with one or more categories of the subset and automatically adding the proposed page to the index server wherein the user can search the proposed page via the link information and wherein initially other users will not search the proposed page even if searching the proposed one or more categories.

Regarding dependent claims 3, 11, and 19, Maarek teaches enabling a user to tailor or cut the index map in p. 1271, section 2.1 and teaches other dynamic browsing hierarchies in p. 1270, section 1, col. 1 line 8 – col. 2 line 18. Maarek does not teach verifying that a uniform resource locator address for the proposed page is valid and that the proposed page is not already indexed under the proposed one or more categories. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Maarek so that it could have verified proposed pages and proposed categories so that the index would not have been redundant.

Regarding dependent claims 4, 12, and 20, Maarek teaches enabling a user to tailor or cut the index map in p. 1271, section 2.1 and teaches other dynamic browsing hierarchies in p. 1270, section 1, col. 1 line 8 – col. 2 line 18. It was well known that the index could have been available on a network to a plurality of users. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Maarek so that other users

could have been allowed to have searched the proposed page when searching one or more of the

proposed one or more categories so that the customized index could have been available to all

the visitors of the topical index.

Regarding dependent claims 5, 13, and 21, Maarek does not teach the step of allowing

the user to rename one or more categories of the subset as it will appear on the hypertext

transmission protocol page controlled by the user. Martinez teaches customizable directories in

fig. 4-5, and col. 1 line 6 – col. 5 line 18. It was well known to one of ordinary skill in the art at

the time of invention that one could organize files, such as hypertext transmission protocol

pages, into a hierarchy of their choosing. The names of topic categories could have been altered.

New categories could have been created and populated, and old categories could have been

deleted. It was well known that the index could have been available on a network to a plurality

of users.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined Martinez into Maarek to have created the claimed invention. It

would have been obvious and desirable to have allowed the user to rename the topic categories

so that the user could have used names which were most familiar to that user.

Regarding dependent claims 6, 14, and 22, Maarek does not teach allowing the user to

rearrange hierarchicalization of one or more categories of the subset as it will appear on the

hypertext transmission protocol page controlled by the user. Martinez teaches customizable

directories in fig. 4-5, and col. 1 line 6 – col. 5 line 18. It was well known to one of ordinary

skill in the art at the time of invention that one could organize files, such as hypertext

transmission protocol pages, into a hierarchy of their choosing. The names of topic categories

could have been altered. New categories could have been created and populated, and old

categories could have been deleted. It was well known that the index could have been available

on a network to a plurality of users.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined Martinez into Maarek to have created the claimed invention. It

would have been obvious and desirable to have allowed the user to rearrange the topic categories

so that the user could have placed the categories in a manner which was easiest for the user

search.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Mortimer et al., US 6,091,930 filed 03/04/1997 discloses a customizable interactive

textbook including a customizable index. May et al., US 5,544,354 filed 08/06/1996 discloses a

user interface for accessing a large database of information using both browsing and searching

behaviors. Nazem et al., US 5,983,227 filed 06/12/1997 discloses a custom page server provided

with user preferences organized into templates. Kaczmarski et al., US 6,314,424 B1 filed

09/28/1998 discloses dynamically expanding and collapsing a tree view for an HTML web

interface. Jones et al., US 6,199,098 B1 filed 02/23/1996 discloses an expandable hierarchical

index in a hypertextual, client-server environment.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The

examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

PJS
January 20, 2004

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER